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PATENT APPLICATION

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Date: August 28, 2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

GROUP ART UNIT: 1794

EXAMINER: NASSER AHMAD

In re application of: John P. Downs)
Application No: 10/770,139)
Filed: February 2, 2004)
Confirmation No.: 9662)
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CON-3)
Customer No. 22922)

For: THERMOPLASTIC ADHESIVE
DISPENSING METHOD AND
APPARATUS

Commissioner for Patents
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APPELLANT'S APPEAL BRIEF

Sir:

In support of the Appeal from the final rejection dated October 30, 2007,
Appellant now submits his Appeal Brief pursuant to 37 C.F.R. §41.37.

I. Real Party in Interest

The real party in interest of the patent application that is the subject of this appeal is Glue Dots International, LLC, the recorded assignee of the entire right, title and interest of the subject application.

II. Related Appeals and Interferences

There is a related and concurrently filed appeal of U.S. Patent Application No. 11/029,611 filed January 4, 2005, entitled "THERMOPLASTIC ADHESIVE DISPENSING METHOD AND APPARATUS," which is a continuation of U.S. Patent Application No. 10/360,357, which is in turn a continuation-in-part of U.S. Patent Application No. 10/125,012. The subject application, U.S. Patent Application No. 10/770,139 is a continuation of U.S. Patent Application No. 10/125,012. All the above-cited patent applications are assigned to the assignee of the present application.

III. Status of Claims

Rejected: 1, 3, 5, 7, 9-14, 16, and 20.

Allowed: none.

Withdrawn: none.

Objected to: none.

Canceled: 2, 4, 6, 8, 15 and 17-19.

Appealed: 1, 3, 5, 7, 9-14, 16, and 20.

IV. Status of Amendments

There was no amendment after the final rejection dated October 30, 2007.

V. Summary of Claimed Subject Matter

All references below are to the specification and drawings of the present application, and pertain to paragraph, page numbers and the line numbers of the paragraph (not the line number on the page). For ease of readability, only one reference to the drawings and to the specification by page, paragraph and line number is made for each claim term or phrase. Each subsequent reference to a claim term typically includes the reference character for ready reference. There is no intent to limit the claims in any manner by references, as this is merely being done for compliance with the Appeal rules.

Claim 1.

Claim 1 recites an adhesive dispensing tape (10 in FIG. 1, pg 9, ¶ [0027], lines 1-2) comprising:

- (a) a flexible carrier tape (14 in FIG. 1, pg. 9, ¶ [0027], lines 4-5) having a transverse width (FIG. 2, pg. 9, ¶ [0029], lines 1-2, pg. 10, ¶ [0032]) defined by first and second edges (FIG. 2) of said carrier tape 14 and a longitudinal length (FIG. 2, pg. 10, ¶ [0032]) comprising a plurality of adjoining longitudinal segments (FIGS. 2 and 3, pg. 10, ¶ [0032]) extending along the entire longitudinal length (FIGS. 2 and 3, pg. 9, ¶ [0028]) of said carrier tape 14, each of said longitudinal segments (FIGS. 1 and 2) extending the entire transverse width (FIGS. 1 and 2) of said flexible carrier tape 14; and
- (b) a plurality of hot melt adhesive segments (22 in FIG. 2, pg. 10, ¶ [0032], line 12) disposed non-contiguously spaced apart (FIGS. 1 and 2) and aligned in columns (FIG. 1, pg. 9, ¶ [0028], lines 1-7) extending along said longitudinal length (FIGS. 1 and 2) of said carrier tape 14, wherein at least two separate ones (FIG. 2) of said adhesive segments 22 are disposed on said carrier tape 14 within each of said longitudinal segments and positioned aligned in side-by-side relation (¶ [0028], lines 1-7) at transversely separated locations (FIG. 2, ¶ [0028], lines 1-7, ¶ [0032]), between said first and said second edges (FIG. 2, ¶ [0029], lines 1-3) of said carrier tape 14 to provide

transversely extending margin (32 in FIG. 2, ¶ [0032], lines 6-10) between an outer edge (FIG. 2, pg. 10, ¶ [0032]) of an adhesive segment 22 and an adjacent one (FIG. 2) of said first and second edges (FIG. 2, pg. 10, ¶ [0032]) of said carrier tape 14 in each of said longitudinal segments that is at least equal to the largest transverse extent (32 in FIG. 2, ¶ [0032], lines 6-10) of the adhesive segment 22; and wherein each of said adhesive segments 22 is individually exposable and dispensable (see 22 and 22' on FIGS. 5-8, ¶ [0035]), to an abutting planar surface (42 or 63 in FIGS. 5-8, (pg. 11, ¶ [0035]) when said carrier tape 14 is transversely flexed (FIGS. 5-8, pg. 11, ¶ [0035]).

Claim 7.

Claim 7 recites an adhesive dispensing tape (10 in FIG. 1, pg 9, ¶ [0027], lines 1-2) comprising:

(a) a flexible carrier tape (14 in FIG. 1, pg. 9, ¶ [0027], lines 4-5) having a transverse width (FIG. 2, pg. 10, ¶ [0032], lines 1-10) dimension defined by first and second edges (FIG. 2, pg. 9, ¶ [0029], lines 1-3, pg. 10, ¶ [0032]) of said carrier tape 14 and a longitudinal length (FIG. 2, pg. 10, ¶ [0032]) dimension comprising a plurality of adjoining longitudinal segments (FIGS. 2 and 3, pg. 10, ¶ [0032]) extending along the entire longitudinal length of said carrier tape, each of said longitudinal segments (FIGS. 2 and 3, pg. 10, ¶ [0032]) extending the entire transverse width (FIG. 2, pg. 10, ¶ [0032]) of said flexible carrier tape 14;

(b) a series of hot melt adhesive segments (22 in FIG. 2, pg. 10, ¶ [0032], line 12) disposed non-contiguously spaced apart (FIGS. 1 and 2) and aligned in columns (FIG. 1, pg. 9, ¶ [0028], lines 1-7) extending along said length (FIGS. 1 and 2) of said carrier tape 14 in the longitudinal direction wherein at least two separate ones (FIG. 2) of said adhesive segments 22 are located within each of said longitudinal segments (FIGS. 1 and 2) of said carrier tape 14 positioned aligned in side-by-side relation (pg. 9, ¶ [0028], lines

1-7) at transversely separated locations (FIG. 2, pg. 9, ¶ [0028], lines 1-7), pg. 10, ¶ [0032]), between said first and said second edges (FIG. 2, pg. 9, ¶ [0029], lines 1-3) of said transverse width of said carrier tape 14, said adhesive segments 22 in each of said columns (FIG. 1, pg. 9, ¶ [0028], lines 1-7) spaced apart longitudinally along the length of said carrier tape providing a longitudinally extending margin between adjacent adhesive segments of a length greater than the longitudinal extent of an adhesive segment, and wherein each of said adhesive segments 22 is individually exposable and dispensable (see 22 and 22' on FIGS. 5-8, ¶ [0035]), to an abutting planar surface (42 or 63 in FIGS. 5-8, (¶ [0035]) when said carrier tape 14 is transversely flexed (FIGS. 5-8, ¶ [0035])).

Claim 16.

Claim 16 recites an adhesive dispensing tape (10 in FIG. 1, pg 9, ¶ [0027], lines 1-2) comprising:

(a) a flexible carrier tape (14 in FIG. 1, pg. 9, ¶ [0027], lines 4-5) having a transverse width (FIG. 2, pg. 10, ¶ [0032]) defined by first and second edges of said carrier tape and a longitudinal length (FIG. 2, pg. 10, ¶ [0032]) comprising a plurality of adjoining longitudinal segments (FIGS. 2 and 3, pg. 10, ¶ [0032]) extending along the entire longitudinal length of said carrier tape, each of said longitudinal segments extending the entire transverse width of said flexible carrier tape; and

(b) a plurality of spaced-apart hot melt adhesive segments (22 in FIG .2, ¶ [0032], line 12) distributed on said carrier tape aligned in columns (FIG. 1, pg. 9, ¶ [0028], lines 1-7) extending along the longitudinal length of said carrier tape 14, wherein at least two separate ones of said adhesive segments 22 are transversely and non-contiguously disposed on said carrier tape 14 within each of said longitudinal segments on said carrier tape 14 and positioned aligned in side-by-side relation (pg. 9, ¶ [0028], lines 1-7) at transversely separated locations (FIG. 2, pg. 9, ¶ [0028], lines 1-7), pg. 10, ¶ [0032]),

between the first and second edges (FIG. 2, pg. 9, ¶ [0029], lines 1-3) of said flexible carrier tape 14 to provide a margin (32 in FIG. 2, pg. 10, ¶ [0032], lines 6-10) extending between an outer edge (FIG. 2, pg. 10, ¶ [0032], lines 6-10) of an adhesive segment 22 and an adjacent one (FIG. 2, pg. 10, ¶ [0032], lines 6-10) of said first and second edges in each of said longitudinal segments that is at least equal to the transverse extent (FIG. 2, pg. 10, ¶ [0032], lines 6-10) of the adhesive segment 22; and wherein each of said longitudinal segments contains the same number of adhesive segments 22 disposed therein and wherein an individual adhesive segment 22 is exposable and dispensable (see 22 and 22' on FIGS. 5-8, ¶ [0035]), to a single substrate (42 or 63 in FIGS. 5-8, (pg. 11, ¶ [0035]) when said carrier tape 14 is transversely flexed (FIGS. 5-8, pg. 11, ¶ [0035])).

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1, 3, 5, 7, 9-14, 16, and 20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Torrey (U.S. Patent No. 3,741,786).

VII. Argument

Prior to turning to the merits of the rejection, Appellant notes the issue for the Board to decide in this appeal is whether Torrey renders the subject matter of any of the rejected claims as a whole obvious within the meaning of 35 USC 103(a). In deciding this issue, the Board needs to make that determination on the basis on the entire record, taking into account the relative persuasiveness of argument. As explained in *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (citations omitted):

"[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

"After evidence or argument is submitted by the applicant in response, patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument.

"If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent."

**Rejection of Claims 1, 3, 5, 7, 9-14, 16, and 20 under
35 U.S.C. 103(a) as being unpatentable over Torrey (3741786).**

A. The Examiner has Failed to Present a *Prima Facie* Case of Obviousness.

To establish a *prima facie* case of obviousness, the Examiner must provide clear articulation of reason(s) why the claimed invention would have been obvious. See MPEP § 2143. There must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR v. Teleflex*, 127 S. Ct. 1727, 1741 (citing to the Federal Circuit statement with approval). More specifically, the Examiner needs to articulate that there is some suggestion or motivation to modify the prior art, that there is a reasonable expectation of success, and that the prior art reference (or references when combined) teaches or suggests all the claim limitations. Indeed, simply identifying all of the elements in a claim in the prior art does not render a claim obvious. *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004).

The Examiner has failed to provide a *prima facie* case of obviousness under 35 U.S.C. § 103(a) based solely on Torrey (U.S. Patent No. 3,741,786). It is asserted that when properly construed, Torrey fails to teach or suggest all the limitations of the present invention. Moreover, the Examiner has not provided any reason one skilled in the art would modify Torrey to achieve the present invention.

1. The Examiner has failed to properly construe Independent Claims 1, 7, and 16.

In construing claim limitations, it must be kept in mind that "as an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

a) Separate Argument with Respect to Claim 1.

Claim 1 recites an adhesive dispensing tape with adhesive segments that are disposed non-contiguously spaced apart manner on the tape, which are aligned in columns extending along the longitudinal length thereof, with at least two separate adhesive segments are disposed within each longitudinal segments of the carrier tape. The adhesive segments, within the longitudinal segment, are aligned in side-by-side relation at transversely separated locations between the first and said second edges of the carrier tape to provide transversely extending margin between an outer edge of an adhesive segment and an adjacent one of the first and second edges of the carrier tape in each of the longitudinal segments that is at least equal to the largest transverse extent of the adhesive segment; and wherein each of the adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed. Here, Claim 1 clearly includes structural language defining the position of the adhesive segments on the carrier tape.

This language clearly defines where each segment must be placed with respect to the remaining adhesive segments on the adhesive segment dispensing tape of the present invention, as illustrated in Appellant's FIGS. 4, 5, and 8, and provides a clear-cut indication of the scope of subject matter embraced by the claims. The functional

language that "each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when the carrier tape is transversely flexed" further defines the structure of the adhesive segment dispensing tape of Claim 1. The spacing of the individual adhesive segments in conjunction with the flexible carrier tape must be capable of providing the stated function that individual adhesive segments are exposable and dispensable to an abutting planar surface.

The Examiner has committed legal error in characterizing the functional language of Claim 1 discussed above as "intended use language" and not giving that language "patentable weight." Final rejection, page 4. The disputed language is not intended use language, but rather adds a functional limitation that imposes structure on the adhesive segment dispensing tape of Claim 1.

The court's opinion in *In re Stencel*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987) is instructive here as the court stated:

"As a matter of claim draftsmanship, appellant is not barred from describing the driver in terms of the structure imposed upon it by the collar having plastically deformable lobes. The framework -- the teachings of the prior art -- against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims themselves are so limited."

The court concluded that "Stencel is not inhibited from claiming his driver, limited by the statement of its purpose, and further defined by the remaining clauses of the claims at issue, when there is no suggestion in the prior art of a driver having the claimed structure and purpose." *Stencel*, 828 F.2d 751 at 755, 4 USPQ2d at 1073. In similar manner, Appellant is claiming the adhesive segment dispensing tape in part by stating the functional properties of the overall structure of the tape. It is entirely proper for Appellant to claim his adhesive segment dispensing tape in this manner and equally improper for the Examiner to ignore this language.

It is sufficient that Claim 1 requires this function, as this requirement imposes the structure necessary for realization of the function.

b) Separate Argument with Respect to Claim 7.

Claim 7 recites that the series of hot melt adhesive segments are disposed in a non-contiguously spaced apart manner and are aligned in columns that extend along the length of the carrier tape in the longitudinal direction, with at least two separate adhesive segments located within each longitudinal segment of the carrier tape. The two segments are aligned in side-by-side relation at transversely separated locations between the first and the second edges of the transverse width of the carrier tape. The adhesive segments are arranged in each of the columns and are spaced apart longitudinally along the length of the carrier tape to provide a longitudinally extending margin between adjacent adhesive segments of a length greater than the longitudinal extent of an adhesive segment, and wherein each of the adhesive segments is individually exposable and dispensable to an abutting planar surface when the carrier tape is transversely flexed.

As discussed with respect to Claim 1, Claim 7 should also be read to include the functional language. This language clearly defines where each segment must be placed with respect to the remaining adhesive segments on the adhesive segment dispensing tape of the present invention, as illustrated in Appellant's FIGS. 4, 5, and 8, and thus, a provides a clear-cut indication of the scope of subject matter embraced by the claims.

c) Separate Argument with Respect to Claim 16.

Claim 16 recites that the plurality of spaced-apart hot melt adhesive segments distributed on the carrier tape aligned in columns extending along the longitudinal length of the carrier tape, wherein at least two separate ones of the adhesive segments are transversely and non-contiguously disposed on the carrier tape within each of the longitudinal segments on the carrier tape and positioned aligned in side-by-side relation

at transversely separated locations between the first and second edges of the flexible carrier tape to provide a margin extending between an outer edge of an adhesive segment and an adjacent one of the first and second edges in each of the longitudinal segments that is at least equal to the transverse extent of the adhesive segment; and wherein each of the longitudinal segments contains the same number of adhesive segments disposed therein and wherein an individual adhesive segment is individually exposable and dispensable to a single substrate when the carrier tape is transversely flexed.

As discussed with respect to Claim 1, Claim 16 should also be read to include the functional language. This language clearly defines where each segment must be placed with respect to the remaining adhesive segments on the adhesive segment dispensing tape of the present invention, as illustrated in Appellant's FIGS. 4, 5, and 8, and provides a clear-cut indication of the scope of subject matter embraced by the claims.

2. The Torrey reference fails to teach or suggest all the limitations of the present invention.

a) Separate Argument with Respect to Claim 1.

When Torrey is read under the appropriate legal standard set forth above and the functional language of Independent Claim 1 is properly construed, it will be seen that Torrey does not teach an adhesive segment dispensing tape within the scope of Claim 1. Specifically, Torrey does not teach or suggest adhesive segments arranged in aligned columns, in transversely separated locations and that the adhesive segments are arranged in a side-by-side relation within the longitudinal section. Torrey does not provide a margin extending between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is at least equal to the largest transverse extent of an adhesive segment, as recited in Claim 1. Moreover, Torrey does not teach or suggest each adhesive segment being individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed.

In contrast, Torrey describes a transfer tape having non-contiguous pressure adhesive patterns. While a superficial consideration of Torrey reveals similarities between the tape of that reference and that of the present invention, a closer reading of the reference as a whole shows that the tape of Torrey differs significantly from the tape required by Claim 1.

The Examiner committed factual error in misreading Torrey in that the tape of Torrey is designed to dispense a plurality of the adhesive segments to a substrate at a time, not to dispense one adhesive segment individually, as required by Claim 1. It is believed that the proper way to read Torrey is that, where the prior art applied a large, individual segment of adhesive, the Torrey invention applies the same amount of adhesive, only in the form of a plurality of non-contiguous segments. Indeed, the adhesive segments on the Torrey tape are arranged in an adjacent or touching manner, and they are not shown arranged in spaced apart columns, in a side-by-side manner or in a manner that provides a margin at least as wide as one of the adhesive segments on the tape.

This is readily seen when the problem solved by Torrey is considered in light of Torrey's disclosure of his invention. Torrey describes as prior art, tapes that are continuously coated with an adhesive where the tape has a release coat so that a portion of the adhesive can be transferred to a substrate. *Id.* col. 1, lines 26-39. Torrey then states that such tapes have several inherent disadvantages in that after application, "the adhesive tends to string or stretch unless it is cut prior to separating the applied adhesive from that remaining on the carrier tape." *Id.*, col. 1, lines 40-44. To overcome that problem, Torrey describes a carrier tape having a release coating wherein a plurality of pressure sensitive adhesive segments are placed on the release coating in a non-contiguous pattern so that any amount of adhesive can be transferred to a substrate by pressure without cutting the carrier tape or adhesive. *Id.*, col. 1, lines 58-67. In reading

Torrey it is seen that he consistently describes the tape of that invention in terms of segments, plural, not singular.

Torrey states:

"As used herein, the term 'a plurality of substantially non-contiguous raised pressure sensitive segments' is meant segments, the raised portions of which are separated from other pressure sensitive adhesive segments by some selected or random distance as well as pressure sensitive segments which are partially attached or which abut adjacent pressure sensitive segments but wherein the cohesive bond at the zone of attachment or abutment is less than the adhesive bond of the pressure sensitive segments for the release coating on the carrier tape such that the pressure sensitive segments can be transferred from the carrier tape without stretching or stringing of the pressure sensitive adhesive."

Id., col. 3, lines 27-39. Torrey amplifies that plural adhesive segments, not an individual adhesive segment, are transferred, stating:

"the cohesive strength of the residue is less than the adhesive bond of the pressure sensitive adhesive segments for the release surface on the carrier tape such that transfer of pressure sensitive adhesive segments from the carrier tape to a substrate may be accomplished without stretching or stringing the raised pressure sensitive adhesive segments."

Id., col. 3, lines 44-50.

Torrey illustrates in Fig. 4 an embodiment where multiple adhesive segments in the shape of bars have been removed from a carrier tape stating at col. 6, lines 32-37:

"with reference to FIG. 4, any portion of the adhesive can be transferred, such as the portion between segments **24** and **26**, from the carrier tape to a substrate without cutting the carrier tape or the adhesive. The applied adhesive will be uniform in nature, not stretched, stringed or distorted."
Emphasis added.

As seen from Fig. 4, plural adhesive segments were removed from the carrier tape, not an individual segment. Figure 4 is consistent with reading the invention of Torrey of, instead of applying a continuous length of adhesive as would have been between 24 and 26 in the

prior art, that length of adhesive was portioned into the non-contiguous bars that are missing from that portion of the Fig. 4 tape.

Importantly, Torrey states that the applied adhesive segments function as discrete segments and that "any change in dimension due to humidity, temperature remain localized and are not propagated throughout a continuous mass of adhesive or the like. This prevents shrinking or curling of the of substrates bonded by the pressure sensitive segments..." Torrey then contrasts that to the situation where expansion, shrinking and curling can occur on a substrate where adhesive is applied as a continuous layer. *Id.*, col. 6, lines 46-58.

From the above analysis it is seen that the proper way to read Torrey is that, where the prior art applied an individual segment of adhesive, the Torrey invention applies the same amount of adhesive, only in the form of non-contiguous segments. Thus, Torrey does not describe a carrier tape having a plurality of adhesive segments that are individually exposable and dispensable as required by Claims 1. Indeed, Torrey does not describe or suggest an adhesive configuration capable of individually exposing and dispensing a single adhesive from the carrier tape to a planar surface, using one of the exemplary dispensing devices shown in Appellant's FIGS. 4-6.

It is understood that under certain factual circumstance, it is proper for the PTO to shift the burden to applicant to establish that a prior art product does not possess the claimed function or property. *See, e.g., In re Best*, 562, F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). However the facts here do not allow for such a shifting of the burden in that Torrey does not provide sufficient details about the construction of the tape of that invention so that a comparison can be made. Torrey does not provide a specific example and describes the carrier tape, release layer and the adhesive to be used in a very generic manner. Nor does Torrey provide any specific details as to the dimensions of the tape or the adhesive segments. In this regard, it is noted that "it is well established that patent drawings do not define the precise proportions of the elements and may not be

relied on to show particular sizes if the specification is completely silent on the issue." *Hockerson-Halbertstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000) ("Under our precedent...it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.") Thus, the Figures of Torrey are of no help in this regard.

In making the rejection the Examiner refers to col. 6, lines 32-37, in support of the proposition that "Torrey teaches that any portion of the adhesive can be transferred from the carrier tape to a substrate, thereby indicating that each adhesive segments is individually exposable and dispensable" Final rejection, page 3. Thus, not only has the Examiner erred by misreading Torrey, the Examiner also errs by misreading the claim. It is asserted that when Torrey and Claim 1 are properly read, Torrey does not teach or describe an adhesive segment dispensing tape within the scope of Claim 1.

b) Separate Argument with Respect to Claim 7.

When Torrey is read under the appropriate legal standard set forth above and the functional language of Independent Claim 7 is properly construed, it will be seen that Torrey does not teach an adhesive segment dispensing tape within the scope of Claim 7. Specifically, Torrey does not teach or suggest a series of adhesive segments arranged in spaced apart, aligned columns, where each longitudinal section of the carrier tape includes at least two separate adhesive segments arranged in a side by side fashion. Further, Torrey does not provide a margin extending between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is greater than the largest transverse extent of an adhesive segment, as recited in Claim 7. Moreover, Torrey does not teach or suggest each adhesive segment being individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed.

As recited above with respect to Claim 1, Torrey does not describe or suggest an adhesive dispensing tape that is configured as recited in Claim 7. Torrey is designed to dispense a plurality of the adhesive segments to a substrate at a time, not to dispense one adhesive segment individually, as required by Claim 7. Rather, the adhesive segments on the Torrey tape are arranged in a contiguous manner, and they are not shown arranged in columns, in a side-by-side manner. The problem solved by Torrey teaches away from a dispensing tape that provides a margin between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is greater than the largest transverse extent of an adhesive segment. If constructed in this manner, dispensing large portions of adhesive to a single substrate is more difficult and inefficient.

Thus, it is asserted that when Torrey and Claim 7 are properly read, Torrey does not teach or describe an adhesive segment dispensing tape within the scope of Claim 7.

c) Separate Argument with Respect to Claim 16.

When Torrey is read under the appropriate legal standard set forth above and the functional language of Independent Claim 16 is properly construed, it will be seen that Torrey does not teach an adhesive segment dispensing tape within the scope of Claim 16.

Specifically, Torrey does not teach or suggest a series of adhesive segments arranged in spaced apart, aligned columns, where each longitudinal section of the carrier tape includes at least two separate adhesive segments arranged in a side-by-side fashion. Further, Torrey does not provide a margin extending between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is at least as equal to the transverse extent of an adhesive segment, as recited in Claim 16. Torrey does not further provide that each longitudinal section of the carrier tape contains the same number of adhesive segments. Moreover, Torrey does not teach or suggest each adhesive segment being individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed.

As recited above with respect to Claim 1 above, Torrey does not describe or suggest an adhesive dispensing tape that is configured as recited in Claim 16. Torrey is designed to dispense a plurality of the adhesive segments to a substrate at a time, not to dispense one adhesive segment individually, as required by Claim 16. Rather, the adhesive segments on the Torrey tape are arranged in a contiguous manner, and they are not shown arranged in columns, in a side-by-side manner. The problem solved by Torrey teaches away from a dispensing tape that provides a margin between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is at least as equal the largest transverse extent of an adhesive segment. If constructed in this manner, dispensing large portions of adhesive to a single substrate is more difficult and inefficient.

Thus, it is asserted that when Torrey and Claim 16 are properly read, Torrey does not teach or describe an adhesive segment dispensing tape within the scope of Claim 16.

3. There is no motivation to modify Torrey.

a) Separate Argument with Respect to Claim 1.

As discussed herein, the adhesive segments on the Torrey tape are arranged in an adjacent or touching manner, and they are not shown arranged in spaced apart columns, in a side-by-side manner or in a manner that provides a margin at least as wide as one of the adhesive segments on the tape. Further, the Torrey tape is not configured to provide an adhesive dispensing tape that in which each adhesive segment is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed. Stated another way, the arrangement of adhesive on an adhesive dispensing tape is clearly not a matter of design choice, it is functional and related to the nature of the problem addressed by the Torrey and the end-use application of the dispensing tape. Indeed, if Torrey was modified in the above recited manner, Torrey would be rendered unsatisfactory for its stated purpose.

More particularly, in the Torrey transfer tape, the close proximity of the adhesive segments as described and shown in the figures intentionally results in multiple adhesive segments being dispensed during a given adhesive application so that large adhesive portions can be dispensed, as described above. This configuration is taught to overcome the limitations of the cited prior art, and provides a significant advantage thereover. One skilled in the art would not be motivated to use the Torrey tape to dispense large portions of adhesive to a single substrate by placing the adhesive on the tape in the manner recited in Claim 1. It is asserted that Torrey teaches and suggests placing adhesive segments as close together as possible on the tape to achieve is recited advantage and function – dispensing large portions of discrete segments to a substrate at a given time. Modification of Torrey in the manner recited in Claim 1 destroys the intended purpose of the Torrey invention.

Accordingly, Claim 1 is not obvious in light of Torrey and allowable at this time. Claim 3, which is dependent upon Claim 1 is believed to be allowable along with its respective parent claim, Claim 1.

b) Separate Argument with Respect to Claim 7.

As recited above, Claim 7 contains similar language as Claim 1, and further recites a margin extending between an outer edge of one of the adhesive segments and an adjacent edge of the carrier tape that is greater than the largest transverse extent of an adhesive segment. Certainly, as described above with respect to Claim 1, Torrey does not teach providing a margin that is greater than the width of an adhesive segment. Because Torrey is directed at a different problem and application, one would not be motivated to provide an adhesive configuration as recited in Claim 7. Accordingly, Claim 7 is not obvious in light of Torrey and allowable at this time. Claims 9-11 and 14, which are dependent upon Claim 7, and are believed to be allowable along with their respective parent claim, Claim 7.

c) Separate Argument with Respect to Claim 16.

As recited above with respect to Claim 1, Claim 16 contains similar structural language, and further includes that there are the same number of adhesive segments disposed in each of the defined longitudinal segments of the carrier tape. There is not teaching or suggestion found in Torrey to provide a carrier tape with longitudinal segments having the same number of adhesive segments. Indeed, the number of adhesive segments in each longitudinal segment of Torrey is inconsequential, since dispensing large portions of closely placed adhesive segments is the subject of Torrey. It is asserted that one skilled in the art would not modify Torrey in this manner, because spacing of adhesive segments as recited in Claim 16 would undermine Torrey's stated advantage and claimed configuration. As such, this modification would render Torrey unsatisfactory for its intended purpose. Accordingly, it is believed that Claim 16 is not obvious in light of Torrey and patentable at this time. As such, Claim 20, which is dependent on Claim 16, is believed to be allowable along with its respective parent claim, Claim 16.

Conclusion

For the foregoing reasons, Appellant respectfully requests that each of the obviousness rejections advanced in the Final Office Action dated October 30, 2007, be reversed and withdrawn and that the Application move forward toward issuance.

Respectfully submitted:

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VIII. Claims Appendix

1. (Previously Presented) An adhesive dispensing tape comprising:

a flexible carrier tape having a transverse width defined by first and second edges of said carrier tape and a longitudinal length comprising a plurality of adjoining longitudinal segments extending along the entire longitudinal length of said carrier tape, each of said longitudinal segments extending the entire transverse width of said flexible carrier tape; and

a plurality of hot melt adhesive segments disposed non-contiguously spaced apart and aligned in columns extending along said longitudinal length of said carrier tape, wherein at least two separate ones of said adhesive segments are disposed on said carrier tape within each of said longitudinal segments and positioned aligned in side-by-side relation at transversely separated locations between said first and said second edges of said carrier tape to provide transversely extending margin between an outer edge of an adhesive segment and an adjacent one of said first and second edges of said carrier tape in each of said longitudinal segments that is at least equal to the largest transverse extent of the adhesive segment; and

wherein each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed.

2. (Cancelled).

3. (Original) An adhesive dispensing tape as defined in Claim 1, wherein said carrier tape has first and second release surfaces, and wherein said adhesive segments adhere less strongly to said second release surface than they do to said first release surface, whereby said carrier tape may be unwound from a coil with said adhesive segments being retained on said first release surface.

4. (Cancelled).
5. (Original) An adhesive dispensing tape as defined in Claim 1, wherein said adhesive segments are disk-shaped.
6. (Cancelled).
7. (Previously Presented) An adhesive dispensing tape comprising:
 - a flexible carrier tape having a transverse width dimension defined by first and second edges of said carrier tape and a longitudinal length dimension comprising a plurality of adjoining longitudinal segments extending along the entire longitudinal length of said carrier tape, each of said longitudinal segments extending the entire transverse width of said flexible carrier tape;
 - a series of hot melt adhesive segments disposed non-contiguously spaced apart and aligned in columns extending along said length of said carrier tape in the longitudinal direction wherein at least two separate ones of said adhesive segments are located within each of said longitudinal segments of said carrier tape positioned aligned in side-by-side relation at transversely separated locations between said first and said second edges of said transverse width of said carrier tape, said adhesive segments in each of said columns spaced apart longitudinally along the length of said carrier tape providing a longitudinally extending margin between adjacent adhesive segments of a length greater than the longitudinal extent of an adhesive segment, and
 - wherein each of said adhesive segments is individually exposable and dispensable to an abutting planar surface when said carrier tape is transversely flexed.
8. (Cancelled).

9. (Original) An adhesive dispensing tape as defined in Claim 7, wherein said series of said adhesive segments are substantially linearly disposed on said carrier tape along the length of said carrier tape.
10. (Original) An adhesive dispensing tape as defined in Claim 7, wherein said width of said carrier tape is defined by first and second edges and wherein said series of adhesive segments is located along said length of said carrier tape between said first and second edges of said width of said carrier tape.
11. (Original) An adhesive dispensing tape as defined in Claim 7, wherein said carrier tape has first and second release surfaces, and wherein said adhesive segments adhere less strongly to said second release surface than they do to said first release surface, whereby said carrier tape may be unwound from a coil with said adhesive segments being retained on said first release surface.
12. (Previously Presented) An adhesive dispensing tape as defined in Claim 11, wherein said adhesive segments have a diameter measured along said first release surface and are separated in the longitudinal direction by a margin at least equal to the diameter.
13. (Previously Presented) An adhesive dispensing tape as defined in Claim 11, wherein said adhesive segments are each circular disks and have a diameter measured along said first release surface and are separated in the longitudinal direction by a margin at least three times the diameter of the circular disks.
14. (Original) An adhesive dispensing tape as defined in Claim 7, wherein said adhesive segments are each disks having a generally circular configuration.
15. (Cancelled).

16. (Previously Presented) An adhesive dispensing tape comprising:

a flexible carrier tape having a transverse width defined by first and second edges of said carrier tape and a longitudinal length comprising a plurality of adjoining longitudinal segments extending along the entire longitudinal length of said carrier tape, each of said longitudinal segments extending the entire transverse width of said flexible carrier tape; and

a plurality of spaced-apart hot melt adhesive segments distributed on said carrier tape aligned in columns extending along the longitudinal length of said carrier tape, wherein at least two separate ones of said adhesive segments are transversely and non-contiguously disposed on said carrier tape within each of said longitudinal segments on said carrier tape and positioned aligned in side-by-side relation at transversely separated locations between the first and second edges of said flexible carrier tape to provide a margin extending between an outer edge of an adhesive segment and an adjacent one of said first and second edges in each of said longitudinal segments that is at least equal to the transverse extent of the adhesive segment; and
wherein each of said longitudinal segments contains the same number of adhesive segments disposed therein and wherein an individual adhesive segment is individually exposable and dispensable to a single substrate when said carrier tape is transversely flexed.

Claims 17-19 (Cancelled).

20. (Original) An adhesive dispensing tape as defined in Claim 16, wherein said carrier tape has first and second release surfaces, and wherein said adhesive segments adhere less strongly to said second release surface than they do to said first release surface, whereby said carrier tape may be unwound from a coil with said adhesive segments being retained on said first release surface.

Claims 21-22 (Cancelled).

IX. Evidence Appendix

None

X. Related Proceedings Appendix

There is a related and concurrently filed appeal of U.S. Patent Application No. 11/029,611 filed January 4, 2005, entitled "THERMOPLASTIC ADHESIVE DISPENSING METHOD AND APPARATUS," which is a continuation of U.S. Patent Application No. 10/360,357, which is a continuation-in-part of U.S. Patent Application No. 10/125,012. The subject application, U.S. Patent Application No. 10/770,139 is a continuation of U.S. Patent Application No. 10/125,012.